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FROM: Lakshmi S. Channavajjala

ART UNIT: 1615

SERIAL NO.: 09/760,307

TO: Mr. Jay Lesser

COMPANY: Darby & Darby

FAX NO.: 212-753-6237

OF PAGES: 2
(including this page)

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PATENT TRADEMARK OFFICE

Docket No: 1946/1A483-US8

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

Milstein et al.

Serial No.: 09/760,307

Art Unit: 1615

Confirmation No.: 8759

Filed: January 11, 2001

Examiner: L. Channavajjala

For: ACTIVE AGENT TRANSPORT SYSTEMS

TERMINAL DISCLAIMER TO OBVIATE

A DOUBLE PATENTING REJECTION RESPONSE

Hon. Commissioner of
Patents and Trademarks
Washington, DC 20231

Sir:

The undersigned is an attorney of record in the above-identified patent application, of which Emisphere Technologies, Inc., located at 765 Old Saw Mill River Road, Tarrytown, New York 10591, is the owner of the entire right, title, and interest in the above-identified patent application by assignment from the inventors.

02/14/2003 MBERHE 00000005 09760307

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The assignment document was recorded by the U.S. Patent and Trademark Office on August 23, 1999 at Reel 10186, Frame 0658.

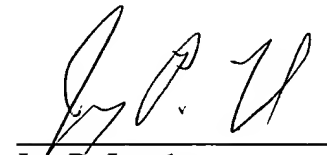
Emisphere Technologies, Inc. hereby disclaims, except as provided below, the terminal part of any patent granted on the above-identified application ("the granted patent") which would extend beyond the expiration date of the full statutory term of U.S. Patent No. 5,935,601 ("the prior patent"), and hereby agrees that the granted patent shall be enforceable only during such period that the legal title to the prior patent shall be the same as the legal title to the granted patent, this agreement to run with the granted patent and to be binding upon the grantee, its successors and assigns.

The statutory fee of \$110.00 for a disclaimer is enclosed.

Emisphere Technologies, Inc. does not disclaim any terminal part of any patent granted on the above-identified U.S. patent application prior to the expiration date of the full statutory term of U.S. Patent No. 5,935,601, in the event that U.S. Patent No. 5,935,601 later:

- expires for failure to pay a maintenance fee;
- is held unenforceable;
- is found invalid;
- is statutorily disclaimed in whole or terminally disclaimed under 37 CFR 1.321(a); or
- has all claims cancelled by a reexamination certificate.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "J. P. Lessler", written over a horizontal line.

Jay P. Lessler
Reg. No. 41,151
Attorney For Applicants

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SUBJECT DECISION ON TERMINAL DISCLAIMERS INFORMAL FORM

DATE: 3-5-03

APPL. S.N.: 091260307

TO EXAMINER: L Channavajjala

ART UNIT: 1615

MOSE MONTGOMERY ROOM 11E18

MAILROOM DATE 2-12-03

AFTER FINAL YES ☒ NO ☐ NUMBER OF T.D(S). FILED 1

INSTRUCTIONS: I have reviewed the submitted T.D. with the results as set forth below. If you agree, please use the appropriate form paragraphs identified by this informal memo in your next office action to notify applicant about the T.D. If you disagree with my analysis or have questions at all about the acceptability of the T.D., please see me or our Special Program Examiner. **THIS MEMO IS AN INFORMAL, INTERNAL MEMO ONLY. IT MUST NOT BE MAILED TO APPLICANT, NOR SHOULD A COPY BE LEFT IN FILE.**

☒ The T.D. is PROPER and has been recorded. (See 14.23).

☐ The T.D. is NOT PROPER and has not been accepted for the reason(s) checked below. (See 14.24).

☐ The recording fee of \$_____ has not been submitted nor is there any pre authorization in the application file to charge to a deposit account. (See 14.26.07)

☐ Application Examiner has not processed T.D. fee. (See fee authorization).

☐ The T.D. does not satisfy Rule 321(b)(3) in that the person who has signed the T.D. has not stated his/her interest (and/or the extent of the interest of the business entity represented by the signature) in the application/patent. (See 14.26 and 14.26.01).

☐ The T.D. lacks the enforceable only during the common ownership clause needed to overcome a double patenting rejection, Rule 321(c). (See 14.27, 14.27.01).

☐ It is directed to a particular claims(s), which is not acceptable since "the disclaimer must be of a terminal portion of the term of the entire patent to be granted". MPEP 1490. (See 14.26, 14.26.02).

☐ The person who signed the terminal disclaimer:

☐ has failed to state his/her capacity to sign for the business entity, (See 14.28).

☐ is not recognized as an officer of the assignee, (See 14.29 and possibly 14.29.01).

☐ No documentary evidence of a chain of title from the original inventor(s) to assignee has been submitted, nor is the reel and frame specified as to where such evidence is recorded in the office. 37 CFR 3.73(b). (See 1140 O.G. 72). **NOTE:** This documentary evidence or the specifying of the reel and frame may be found in the T.D. or in a separate paper submitted by applicant. (See 14.30).

☐ No "statement" specifying that the evidentiary documents have been reviewed and that, to the best of the assignee's knowledge and belief the title is in the assignee seeking to take action. 37 CFR 3.73(b). (See 1140 O.G. 72) (See 14.31).

☐ The T.D. is not signed. (See 14.26, 14.26.3). or 14.26.03 if TD is not signed by all the owners.

☐ Attorney not of record in oath/decl. or a separate paper filed appointing a new or associate attorney. (See 14.29.01).

☐ The serial number of the application (or the number of the patent) which forms the basis for the double patenting is missing or incorrect. (See 14.32).

☐ The serial number of this application (or the number of the patent in reexam or reissue case(s) being disclaimed is missing or incorrect. (See 14.26, 14.26.04 or 14.26.05).

☐ The period disclaimed is incorrect or not specified. (See 14.27, 14.27.2 or 14.27.3)(For Samples 14.27.04 and 14.27.05)

☐ Other: _____

☐ Suggestion to request refund of \$_____. (See 14.35, 14.36).

EXAMINER NOTE: IF APPLICATION IS IN CONDITION FOR ALLOWANCE ANY OF THE ABOVE INFORMALTIES MAY BE FAXED IN TO THE GROUP

FOR SAMPLE TERMINAL DISCLAIMERS AND CERTIFICATES:

☐ Sample of a TD over a pending application and assignee Certificate (See 14.37).

☐ Sample of a TD over a prior patent and assignee Certificate (See 14.38).

☐ Sample Assignee Certificate under 37 CFR 3.73 (b) (See 14.39)